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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,011	01/22/2002	Guerin Dubose Rife	RIF-114	7788

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EXAMINER

DUONG, THANH P

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,011

Applicant(s)

RIFE, GUERIN DUBOSE

Examiner

Tom P Duong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 18, 19 and 33-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18, 19 and 33-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 39, the limitation " a bottom edge of said upper portion is defined by a ledge coincident with a top edge..." is indefinite and inaccurate. Herein, a ledge is best understood to be the cavity upper side wall 130 coincident with the interface 123. (See Applicant's disclosure page 9, lines 20-22).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 33-34, 38-39 and 41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gorman (5,048,835). Regarding claims 33-34, 38 and 41, Gorman discloses an iron golf club (Figures 1- 2) including a hosel portion 12 to receive a shaft (Col. 3, line 5), heel 10, toe 4, striking surface 18, weighted mass 26, top ridge surface 6, bottom sole surface 8, a rear surface 20 having upper portion and low portion, wherein the upper portion extending

downwardly toward bottom sole approximately one-third the distance between the top ridge and bottom sole, and lower portion is approximately two-thirds of rear surface extending in direction from bottom sole to top ridge, and walls defining the outer perimeter of elongated cavity 24. Regarding claim 39, the second wall 32 shows a ledge or wall which define the transition between the upper portion and lower portion. To the extend the distance might not be exactly as claimed, it would be an obvious matter of routine optimization to alter the distances to be as claimed in as much as the club will work equally well.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-19, 35-37, 42-49, 51-58, and 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorman '835 in view of Besnard et al. (5,643,112) and Teramoto et al. (4,645,207). Regarding claims 18-19 and 35-37, Gorman does not shows a striking face that is thinner than the thickness between the non-cavity portions of the rear surface. Besnard '112 shows the rear main cavity extending towards the striking face, which inherently thinner than the rest of the periphery portions (Abstract) in order to improve mass distribution. Teramoto et al. shows on Figure (4a) a hollow portion 13 or cavity located in the rear lowermost portion of the striking face to in order to obtain a lower center of gravity and large sweet spot. (Col. 3, lines 60-68). Thus, it

would have been obvious in view of Besnard and Teramoto to one having ordinary skill in the art to modify the rear cavity configuration of Gorman to include a thinner face as taught by Besnard and having rear cavity in the lowermost portion of the rear face in order to improve mass distribution, lower center of gravity, and increased in sweet spot. Regarding claims 42 and 52, both Gorman and Teramoto shows the top portion having a blade like structure. Claims 42-49, 51-58, and 60-61 recite limitations similar to claims 33-39 and 41; thus, claims 42-49 are rejected for the same reasons as applied in claims 33-39, and 41, above.

4. Claims 16, 40, 50 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art as applied in claim 33, above and further in view of Shimasaki (5,562,551). Gorman '835 does not disclose an insert material located within the cavity; however, Shimasaki 551' further teaches an insert 21 is provided inside the cavity to further improve the moment of inertia and to control the center of gravity. (Col. 1, lines 56-65). Thus, it would have been obvious and desirable in view of Shimasaki to one having ordinary skill in the art to include the insert in Gorman's rear cavity in order to improve moment of inertia and control center of gravity. Regarding claim 16, Official Notice is taken that it is conventional to provide such undercut retention to retain the insert and it would have been obvious to do here to gain the same benefits.

Response to Arguments

Applicant's arguments filed 1/2/03 have been fully considered but they are not persuasive. Applicant argues that the prior art does not shows a cavity confined to the lower portion of the rear surface. Teramoto '207 shows several embodiments having hollow portion 13 or cavity on Figures 4 (a-c) which is located in the rear, lower portion surface in order to obtain a club with lower center of gravity, large sweet spot, improved shots accuracy. With respect to the relative location of the perimeter weight cavity on the bottom half of the rear surface, Gorman shows a perimeter cavity located in the two-thirds portion of the rear surface measuring from the bottom sole surface to the bottom edge of second wall 32. Likewise, if desirable, there is nothing unobvious about extending the cavity of Gorman to the upper rear portion as shown in Besnard '112 and Shimasaki '208 by having more weight in the outer perimeter of the upper and lower rear portion in order to improve mass distribution.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7768 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-4148.

Tom Duong
March 11, 2003


Paul T. Sewell
Supervisory Patent Examiner
Group 3700